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| 09/544,150 | 04/06/2000 | Louis J Pinga | P006 P00252-US | 9167 |
| 3017 | 7590 | 03/24/2004 | EXAMINER | |
| BARLOW, JOSEPHS & HOLMES, LTD. 101 DYER STREET 5TH FLOOR PROVIDENCE, RI 02903 | | | SHIH, SALLY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3624 | |

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/544,150

Applicant(s)

PINGA ET AL.

Examiner

Sally Shih

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is response to Applicant's amendment filed on June 17, 2003. The rejections are as stated below:

Withdrawn of Finality

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Specifically, the claim of priority is accepted.

Status of Claims

3. Of the original claims 1-23 and previously added claims 24-30, claims 1 and 24 have been amended. Accordingly, claims 1-30 are under prosecution in this application.

Summary of this Office Action

4. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection. Therefore, claims 1-30 are rejected as being unpatentable over the art cited below, and Applicant's request for allowance is respectfully denied.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferguson et al.

(United States Patent Number 5,991,736).

Claims 24-30: Ferguson et al. discloses a computerized method for implementing an expenditure tracking, reward, and investment program. Specifically, the method of establishing an account, making deposit, tracking and redeeming the deposit associated with a card with an independent financial institution where such tax-deferred investment account can be used as a retirement account is disclosed in at least col. 4, lines 52-59, col. 5, lines 41-49 and col. 6, lines 47-58.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (United States Patent Number 5,991,736).

Claim 1: Ferguson et al. teach a method for implementing a patron betting, rating, and investment program, said method comprising the steps of establishing an investment account for

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the benefit of a patron and making deposits and withdrawn therein (col. 4, lines 52-59; col. 5, lines 41-49).

However, Ferguson et al. failed to explicitly specify an investment method and system use in connection with a casino. The examiner takes Official Notice that providing an investment account in connection with an entertainment service is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to include casino as one of participants of such invention because Fig. 4 has an entertainment category that listed various of entertainment services such as audio, book, music and an option key for more entertainment services. Casino service is categorized as an entertainment service. The use and advantages of the step of not listing all of the available services are well known.

Claims 2, 7, 8, 9 and 10: Ferguson et al. teach the method of claim 1 wherein said step of making a deposit comprises the step of depositing cash into said investment account (Fig. 2-4 and column 14, lines 23-25). However, Ferguson et al. failed to explicitly specify an investment method and system use in connection with a casino. The examiner takes Official Notice that providing an investment account in connection with an entertainment service is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to include casino as one of participants of such invention because Fig. 4 has an entertainment category that listed various of entertainment services such as audio, book, music and an option key for more entertainment services. Casino service is categorized as an

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entertainment service. The use and advantages of the step of not listing all of the available services are well known.

Claims 3, 11, 12 and 13: Ferguson et al. teach the method of claim 1 wherein said step of making a deposit comprises the steps of establishing a formula for calculating and issuing of awards (see at least fig. 1; col. 6, lines 47-60).

However, Ferguson et al. failed to explicitly specify having rating points to be awarded to a patron during game play. The examiner takes Official Notice that one would be able to award rating or loyalty points at any given time specified. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a feature to indicate the time period in which the rating or loyalty points are to be awarded because it takes certain amount of time to calculate and process the points. The use and advantages of this step are well known.

Claim 4: Ferguson et al. teach the method of claim 3 further comprising the step of issuing said patron an investment rating card that is associated with said investment account of said patron (col. 4, lines 56-57; col. 6, lines 48-49). However, Ferguson et al. failed to explicitly specify issuing a hard copy card. The examiner takes Official Notice that one would be able to print out a hard copy of the investment account identifier on paper in the form of a card from the invention as described in Ferguson. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the capability of printing because hard copies are desirable for the purposes for record keeping. The use and advantages of this step are well known.

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Claims 5, 14, 15 and 16: Ferguson et al. teach the method of claim 1 wherein said step of making a deposit comprises the steps of establishing awards in several forms such as electronic funds (col. 6, lines 5-6).

However, Ferguson et al. failed to explicitly specify the use of betting chips. The examiner takes Official Notice that one would have the flexibility of choosing various medium such as paper documentations, cash, chips or even electronic currencies as the form of rebates for redeeming the loyalty points. It would have been obvious to one of ordinary skill in the art at the time of the invention to include various forms of currencies because cash alone is just not convenient as shown by use of credit cards, debit cards and electronic monies. The use and advantages of this step are well known.

Claims 6, 17, 18 and 19: Ferguson et al. teach the method of claim 1 wherein said step of making a deposit comprises the steps of establishing a conventional rating account for the benefit of said patron, issuing awards based on calculations made and redeeming award thereof (see at least fig. 1; col. 6, lines 47-60).

However, Ferguson et al. failed to explicitly specify an investment method and system use in connection with a casino. The examiner takes Official Notice that providing an investment account in connection with an entertainment service is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to include casino as one of participants of such invention because Fig. 4 has an entertainment category that listed various of entertainment services such as audio, book, music and an option

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key for more entertainment services. Casino service is categorized as an entertainment service. The use and advantages of the step of not listing all of the available services are well known.

Claims 20 and 22: Ferguson et al. teach the method of claim 1 wherein said investment account is operated and maintained by a sponsor for the sponsor's goods or services (abstract; col. 4, lines 39-45).

However, Ferguson et al. failed to explicitly specify casino as the merchant or as a sponsor who provides goods or services to the customer or patron. The examiner takes Official Notice that one would consider a casino as a merchant. It would have been obvious to one of ordinary skill in the art at the time of the invention to include casino as one of the merchants as described of such invention because Fig. 4 has an entertainment category that listed various of entertainment services such as audio, book, music and an option key for more entertainment services. Casino service is categorized as an entertainment service. The use and advantages of the step of not listing all of the available services are well known.

Claims 21 and 23: Ferguson et al. teach the method of claim 1 wherein said investment account is operated and maintained by an independent financial institution (col. 5, lines 41-43).

However, Ferguson et al. failed to explicitly specify an investment method and system use in connection with a casino. The examiner takes Official Notice that providing an investment account in connection with an entertainment service is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to include casino as one of participants of such invention because Fig. 4 has an entertainment

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category that listed various of entertainment services such as audio, book, music and an option key for more entertainment services. Casino service is categorized as an entertainment service. The use and advantages of the step of not listing all of the available services are well known.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sally Shih whose telephone number is 703-305-8550. The examiner can normally be reached on Flexible.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

sys

RICHARD WEISBERGER
PRIMARY EXAMINER